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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/686,235	10/11/2000	Frederic L. Way II	TS097-cipsLED	6103

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George W. Dishong, Esq.
DISHONG LAW OFFICES
40 Bryant Road
Jaffrey, NH 03452

EXAMINER

KLEBE, GERALD B

ART UNIT PAPER NUMBER

3618

DATE MAILED: 04/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/686,235	WAY ET AL.	
	Examiner	Art Unit	
	Gerald B. Klebe	3618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 May 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

G.B. Klebe
21 April 2005

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Amendment

1. The Request for Continued Examination filed 02/25/2005 and the amendment filed 02/25/2005 under 37 CFR § 1.111 have been entered. Claims 20-29 are pending in the application, claims 1-19 being cancelled and new claim 29 being added by the amendment. Where the new claims are added, Applicant has neglected to list, as required by the restriction, all claims readable on the elected species. The examiner notes that the newly added claim 29 appears to read on the elected species Group IV, Fig. 12.

An examination on the merits follows.

Claims Rejections-- 35 USC § 112, First Para.

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 29 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 29 in lines 4-5 recites "a lower-positioned thigh-to-knee region; and an ankle and foot support region elevated relative to said thigh-to-knee region." No support can be found for these features in the disclosure as filed including the drawings. No support is found for the feature of region for the thigh-to-knee region nor an ankle and foot support region nor for any disclosure of an ankle and foot support region that is elevated relative to a thigh-to-knee region.

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Appropriate correction is required. No new matter should be entered.

For purposes of further examination on the merits, the claim will be interpreted by the examiner as if reading without the unsupported recitations of the thigh-to-knee region and ankle and foot support region which is elevated with respect to the thigh-to-knee region.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 20 is rejected under 35 U.S.C. 102 (b) as being anticipated by Volz (US 1409501).

Volz discloses a gravity driven steerable vehicle for use on snow covered terrain comprising: a chassis (1) having a front, rear, and underside and a topside; a rider riding surface on the top side comprising means for (taken as the top surface of item 1) orienting a rider in a prone, face down, face forward position (refer lines 64-66); means (2) for attaching a rear axle assembly (3) substantially at the chassis rear (refer lines 35-37); means (5) for mounting a front axle assembly (6) at the chassis front (refer lines 37-40); means (5) for steering the vehicle by the rider (refer lines 61-66); two rear hub and spindle assemblies (11, 12 and 14 (refer lines 51-57); wherein the ends of the axles 3, 6 serve as spindles (refer lines 42-46)); refer lines 47-48) integral with the rear axle assembly, one rear hub and spindle assembly at each end of the rear axle assembly; and two front hub and spindle assemblies integral with the front axle assembly, one front hub and spindle assembly at each end of the front axle assembly; and means for attaching one ski (10) assembleable to each of the two rear hub and spindle assemblies and to each of the two front hub and spindle assemblies (refer lines 46-61).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Volz (US 1409501) in view of Redling (US 2353501).

As discussed above, Volz discloses all of the features of claim 20 from which claim 21 depends. Volz lacks explicit disclosure of a braking feature.

Redling teaches a snow sled having a manually actuated brake (combination 42, 43, 44).

It would have been obvious to one of ordinary skill in the art at the time the instant invention was made to have modified the sled of Volz to incorporate a hand brake in accordance with the teachings of Redling as a safety feature to keep the sled stationary when the rider was entering or exiting from the sled as suggested by the reference at column 1, lines 41-45.

8. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Volz (US 1409501) in view of Dandurand (US 2770465).

As discussed above, Volz discloses all of the features of claim 20 from which claim 22 depends. Volz lacks explicit disclosure of a harness for the rider.

Dandurand teaches a harness (24) for securing a rider onto the riding surface of a sled.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the instant invention was made to have modified the sled of Volze to incorporate a harness in accordance with the teachings of Dandurand in order to secure the rider onto the riding surface as a safety measure and to provide a more comfortable ride during maneuvers.

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9. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Volz (US 1409501) in view of Gibbons (US 6116622).

As discussed above, Volz discloses all of the features of claim 20 from which claim 28 depends. Volz lacks explicit disclosure of a combination roll bar and tote bail for sled.

Gibbons teaches a roll bar and bail (32) for a snow sled.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the instant invention was made to have modified the sled of Volz to incorporate a combination roll bar and tote bail in accordance with the teachings of Gibbons in order to provide safety in case of sled overturning during riding and whereby the sled could be at least partially lifted for transport when not being used.

10. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Volz (US 1409501) in view of Redling (US 2353501) and further in view of Dandurand (US 2770465).

As discussed above, the combination of Volz and Redling discloses all of the features of claim 21 from which claim 23 depends. The combination of Volz and Redling lacks explicit disclosure of a harness for the rider.

Dandurand teaches a harness (24) for securing a rider onto the riding surface of a sled.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the instant invention was made to have modified the sled of the combination of Volz and Redling to incorporate a harness in accordance with the teachings of Dandurand in order to secure the rider onto the riding surface as a safety measure and to provide a more comfortable ride during maneuvers.

11. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Volz (US 1409501) in view of Berthold et al. (US 4291892).

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As discussed above, Volz discloses all of the features of claim 20 from which claim 24 depends. Volz lacks explicit disclosure of shock absorbing means between the front attached skis and the front axle assembly.

Berthold et al. teaches a gravity driven steerable snow vehicle having shock absorbing means between the front skis and the front axle assembly.

Therefore, it would have been obvious for one of ordinary skill in the art at the time the instant invention was made to have modified the sled of Volz to have shock absorbers on the front skis between the skis and the axles in accordance with the teachings of Berthold et al. in order to cushion the ride over uneven terrain as suggested by the reference at column 1, lines 22-27.

12. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Volz (US 1409501) in view of Dandurand (US 2770465) in further view of Berthold et al. (US 4291892).

As discussed above, the combination of Volz and Dandurand discloses all of the features of claim 22 from which claim 25 depends. The combination of Volz and Dandurand lacks explicit disclosure of shock absorbing means between the front attached skis and the front axle assembly.

Berthold et al. teaches a gravity driven steerable snow vehicle having shock absorbing means between the front skis and the front axle assembly.

Therefore, it would have been obvious for one of ordinary skill in the art at the time the instant invention was made to have modified the sled of the combination of Volz and Dandurand to have shock absorbers on the front skis between the skis and the axles in accordance with the teachings of Berthold et al. in order to cushion the ride over uneven terrain as suggested by the reference at column 1, lines 22-27.

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13. Claims 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Volz (US 1409501) and Redling (US 2353501) in view of Dandurand (US 2770465) and further in view of Berthold et al. (US 4291892).

As discussed above, the combination of Volz, Redling and Dandurand discloses all of the features of claim 23 from which claims 26 and 27 depend. The combination of Volz, Redling and Dandurand lacks explicit disclosure (re: claim 26) of shock absorbing means between the front attached skis and the front axle assembly.

Berthold et al. teaches a gravity driven steerable snow vehicle having shock absorbing means between the front skis and the front axle assembly.

Therefore, it would have been obvious for one of ordinary skill in the art at the time the instant invention was made to have modified the sled of the combination of Volz, Redling and Dandurand to have shock absorbers on the front skis between the skis and the axles in accordance with the teachings of Berthold et al. in order to cushion the ride over uneven terrain as suggested by the reference at column 1, lines 22-27.

Regarding the further limitations of Claim 27, wherein the sled has shock absorbing means between the skis and the axle assembly attached to each of the two rear hub and spindle assemblies, it would have been obvious to one of ordinary skill in the art at the time the instant invention was made to have further modified the sled having shock absorbing means attached between the skis and axle assemblies at the front of the sled to include, as well, shock absorbing means attached between the skis and axle assemblies at the rear of the sled since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. V. Bemis Co.*, 193 USPQ 8.

14. Claim 29, as understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over Volz (US 1409501) in view of Birkhead (US 2103998).

As discussed above, Volz discloses all of the features of claim 20 from which claim 29 depends. Volz lacks explicit disclosure wherein the means for orienting the rider in a prone, face-down, face forward position comprises an upper-body supporting section that is inclined upwards from rear to front of the vehicle

However, Birkhead teaches a gravity driven steerable vehicle wherein the means for orienting the rider in a prone, face-down, face-forward position comprises an upper-body supporting section that is inclined upwards from rear to front of the vehicle (refer Fig 2).

Therefore, it would have been obvious for one of ordinary skill in the art at the time the instant invention was made to have modified the sled of Volz to have its upper-body supporting section for the rider inclined upwards from rear to front of the vehicle in accordance with the teachings of Birkhead as an obvious design choice in order to reduce the stress on the rider's musculature to keep his/her head up at a comfortable position for guiding and steering the vehicle in downhill gliding.

Claims Rejections - Double Patenting

15. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting

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ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

16. Claims 20-29 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, and 9 of U.S. Patent No. 6,276,700 in view of Volz (US 1,409,501).

Although the conflicting claims are not identical, they are not patentably distinct from each other because the differences, using skis instead of wheels as the support elements for the vehicle, represent obvious modifications taught by Volz (-501) wherein it would have been obvious to one of ordinary skill in the art at the time the instant invention was made to have substituted skis in place of the wheels at the front and rear of the vehicle as suggested by Volz at lines 11-20.

Response to Arguments

17. Applicant's arguments filed 02/25/2005 have been fully considered but they are not persuasive.

a. Regarding Applicant's arguments that Volz does not disclose or suggest a sled riding surface with means for causing/orienting a rider in a prone, face down, face forward inclined position, or with chest raised Applicant is relying on features not claimed [examiner's emphasis added in exposition] (specifically, it is not claimed that the means provided functions to orient the rider's prone position inclined or with chest raised).

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b. In response to Applicant's argument against the combination of Berthold with Volz where the teachings of Berthold are used to make obvious the use of shock absorber means between front and/or rear attached skis and front and/or rear axle assemblies, and against the combination of Dandurand with the combination of Volz and Redling to make obvious the use of a harness to secure the rider to the sled, it has been held that the test for obviousness is not whether the features of one reference may be bodily incorporated into the other to produce the claimed subject matter but simply what the combination of references makes obvious to one of ordinary skill in the pertinent art. *In re Bozek*, 163 USPQ 545 (CCPA 1969).

c. Regarding Applicant's argument against the double-patenting rejection of claims 20-27, Applicant misinterprets the rejection. In the rejection, the claims are rejected on the basis that the difference between the already patented claims granted the Applicant in US 6,276,700, the reference to Volz is relied upon *only* [examiner's emphasis in explanation] for the teaching that substituting ski runners front and rear for front and rear wheels of a gravity driven steerable vehicle is old and well-known and therefore an obvious substitution to one of skill in the art at the time the instant invention was made.

Prior Art made of Record

18. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The prior art of Bogdanovich, of Birkhead, of Olivieri, of Fitzgerald, of DiMille et al., and of Barbee each show features in common with some of the other structures of the inventive concept disclosed in the instant application.

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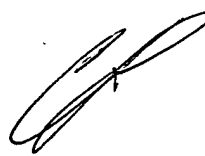
Conclusion

19. Any inquiry concerning this or earlier communication(s) from the examiner should be directed to Gerald B. Klebe at 571-272-6695; Mon.-Fri., 8:00 AM - 4:30 PM ET, or to Supervisory Patent Examiner Christopher P. Ellis, Art Unit 3618, at 571-272-6914.

Official correspondence should be sent to the following TC 3600 Official Rightfax numbers as follows: Regular correspondence: 703-872-9326; After Finals: 703-872-9327; Customer Service: 703-872-9325.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

gbklebe
gbklebe / Art Unit 3618 / 21 April 2005


CHRISTOPHER P. ELLIS
SUPERVISORY PATENT EXAMINER
ART UNIT 3618